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8/11/04

MAIL STOP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of : Group Art Unit 1626
Jonathon L. Sessler *et al.* :
:
Conf. No.: 3535 :
:
Appln. No. 09/939,514 : Examiner: Robert Gerstl
:
Filed: August 24, 2001 :
: Attorney Docket
For: HALOGENATED CALIXPYRROLES, : No. 045404-1U2
CALIXPYRIDINOPYRROLES AND :
CALIXPYRIDINES, AND USES :
THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

This Response to Restriction Requirement is timely filed on August 11, 2004, in view of the Petition for a Five Month Extension of Time.

Claims 1-11 and 31-51 are pending in the application.

In the Restriction Requirement issued by the Examiner the Examiner has restricted the claims 1-11 and 31-51 into eight groups:

Group I - claims 1-4, 9-11, and 49, drawn to products of the structure I variously classified in classes 540 and 548;

Group II - claim 5 drawn to polymer matrix products variously classified in class 424;

Group III - claim 6 drawn to membrane products variously classified in class 516;

Group IV - claim 7 drawn to liposome products variously classified in class 428;

Group V - claim 8 drawn to products of the structure VI variously classified in classes 540 and 548;

Group VI - claims 31 and 32 drawn to processes for the preparation of structure I variously classified in classes 540 and 548;

Group VII - claims 33-46 drawn to methods of use for the structure I variously classified in class 514;

Group VIII - claims 50 and 51 drawn to processes for the preparation of the structure VI variously classified in classes 540 and 548.

The Examiner argues that inventions I and VI are related as a process of making a product and the product made, as are inventions of Group V and Group VI. However, the Examiner argues that the inventions of Groups I and VI are distinct because the process can be used to make other “materially different” products such as the compound of structure VI. With respect to the inventions of Group V and Group VIII, the Examiner argues that the inventions are distinct because the process can be used to make the compound of structure I.

With respect to the inventions of Groups I, II, III, IV, and V, the Examiner argues that they are independent and distinct products because they differ in the values for “n” and for “R” and moreover because the products of Group I and Group V are compounds whereas the inventions of Group II, Group III, and Group IV are a polymer matrix, a membrane, and a liposome, respectively.

The Examiner argues that the inventions of Group VI and Group VIII are independent and distinct processes because of the use of different reactants and reaction conditions and products, relying primarily on the fact that the process of Group VI prepares compounds of the structure I and the process of Group VIII prepares compounds of the structure VI.

The Examiner argues that the inventions of Groups I and VII are related as product and processes of use but are distinct because the process for using the product can be practiced with another materially different product, such as, aluminum hydroxide or calcium carbonate cocktails.

The Examiner contends that the inventions of Groups II-IV and VI-VIII are unrelated as they are not disclosed as capable of use together since the processes of Group VI and Group VIII function to prepare the compounds VI and I and do not prepare the polymer matrix, membrane, or liposomes.

Finally, the Examiner argues that the inventions of Group V and Group VII are unrelated as they are not disclosed as capable of use together.

The applicants respectfully traverse the rejection.

As a threshold matter, the applicants object in the strongest terms to the issuance of this restriction requirement and request its prompt withdrawal on the grounds that its imposition is unduly prejudicial to the applicant. This application was filed in 2001, numerous Office Actions have been issued and responded to, at considerable time and expense on the part of the applicant. During three years of correspondence with the Examiner, no restriction requirement had been imposed on the initially filed claims. Indeed all but one issue related to the patentability of those claims had been successfully resolved. It is only now, in 2004, that the Examiner has imposed an eight-way restriction requirement, effectively forcing the applicants to “re-prosecute” the application eight times, and effectively eroding the patent term on any result patents because of the additional prosecution required. The resultant prejudice to the applications because of the USPTO’s apparent carelessness in failing to restrict the application at the outset (three years ago) is great.

In a teleconference with Examiner Anderson, this issue was discussed. Examiner Anderson reported that the restriction requirement was necessary because Examiner Gerstel was “mistaken” in examining the application as if the claims constituted one invention. The applicants respectfully submit that, even if this was true, imposition of an eight-way restriction in the application at this late date in the prosecution imposes an undue burden on the applicants and punishes the applicants for an alleged error on the part of the USPTO, by forcing re-prosecution of the application, eight times.

Moreover, the restriction imposed by the Examiner is not proper. The technologies described in this application are all related and are not distinct from one another. Claims 1-4, 9-11 and 49 describe specific compounds, each of which may be incorporated into a polymer matrix (claim 5), a membrane product (claim 6) or a liposome (claim 7). Thus, a search of the compounds of Group I will result in any information and prior art related to at least Groups II, III, IV and V.

Similarly, claims 31, 32 (Group VI) and 33-46 (Group VII) describe methods of manufacture of structure I and methods of use for the compounds of structure I; and, at least in the case of Group VI and VIII, they are the same classification.

PROVISIONAL ELECTION

In view of the foregoing, it is requested that the Examiner reconsider and rejoin the claims of all groups and examine them all together, as was initially done by Examiner Gerstl in the prior three years of prosecution.

Alternatively, it is requested that the Examiner rejoin the claims of Groups I, II, III, IV, V, VI and VIII, together, thereby imposing a two way restriction.

CONCLUSION

In view of the foregoing, and in view of the findings of Examiner Gristl in the prior prosecution, it is submitted that all claims are allowable over the prior art. Examination and allowance of the claims at the earliest opportunity is respectfully requested.

Respectfully submitted,

JONATHAN L. SESSLER, et al.

11 August 2004
(Date)

By:

Kristyne A. Bullock

KRISTYNE A. BULLOCK

Registration No. 42,371

AKIN GUMP STRAUSS HAUER & FELD LLP

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

Direct Dial: 215-965-1348

Facsimile: 215-965-1210

E-Mail: kbullock@akingump.com

KAB:cmb
7249471